7   presentation element sub-structures, referred to by the play-out specification sub-

8   structure;

9   • retrieving at least one play-out specification portion from a first location in the data

10   structure, which play-out specification portion specifies timing behavior of at least one

11   respective presentation element within the data structure; and

12   • responsive to the play-out specification, retrieving the at least one respective presentation

13   element from a second location in the data structure.

1   44. The method of claim 43, comprising accessing a self-contained, sub-sub-presentation data

2   structure from within the sub-presentation data structure, which sub-sub-presentation data

3   structure comprises at least one play-out specification sub-sub-structure and a plurality of

4   presentation element sub-sub-structures.

REMARKS

The present amendment is offered to introduce some new claims, more narrowly directed

to the preferred embodiment, in the hopes that the Examiner will like them better. Applicant

trusts that the Examiner will agree that the newly claimed method using the claimed data

structures is not taught or suggested by the Moorby reference, which shows only a graphical user

interface and has nothing to do with data structures. Moreover, the claims clearly recite that they

relate to sub-presentation data structures of a multi-media presentation; which is not taught or

suggested by Gudmondson's containers, which relate to object-oriented programming.

With respect to the prior rejections, Applicant would like to offer the following additional

remarks, while incorporating the prior remarks by reference.

Rejection under Section 101

In the 101 rejection, the Examiner has stated that the medium claims lack functional recitations. Applicant respectfully disagrees. A play-out specification is recited which indicates how a presentation element is to be played. This is a functional recitation. The play-out specification has a function with respect to the presentation element. Accordingly, these claims are not at all analogous to a mere recording of data.

Art rejections: Incorporating definitions of terminology from the specification

In the 102 rejection, the Examiner apparently fails to use the definition of "presentation element," from the specification. Applicant respectfully submits that this is improper. MPEP 608.01(o) states

"A term used in the claims may be given a special meaning in the description."

MPEP 2173.01 states

A fundamental principle contained in **35 U.S.C. 112**, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art.

MPEP 2173.05 (a) states

The meaning of every term used in a claim should be apparent from the prior art or from the specification and drawings at the time the application is filed. Applicants need not confine themselves to the terminology used in the prior art, but are required to make clear and precise the terms that are used to define the invention whereby the metes and bounds of the claimed invention can be ascertained. During patent examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification. *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969). See also **MPEP § 2111 - § 2111.01**. When the specification states the meaning that a term in the claim is intended to have, the claim is examined using that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art. *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989).

Accordingly, the Examiner is not at liberty to ignore the definitions of terms from the specification. This is different from reading limitations from the specification into the claims.

Let us consider some hypothetical examples. Suppose a patent application shows, as the preferred embodiment, a chair with four legs; and the claim recites "a chair with a plurality of legs." Then the fact that the preferred chair has four legs could not be read into the claims. Suppose, by contrast, the specification says "a chair is a piece of furniture with four legs." This is not just a statement of the preferred embodiment. This is a definition of terms. The claims do have to be read as incorporating such definitions. Therefore, in this second example, if the claim says "a chair," it must be assumed to have four legs.

Applicability of 37 CFR 1.104(c)(2)

This regulation specifies

> (2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

The rejections cite complex references. The Examiner fails to indicate which part of which claim is rejected over which part of the reference. Applicant respectfully submits that this is improper; and that the rejections accordingly fail to satisfy 37 CFR 1.104(c)(2), especially with respect to the dependent claims.

Applicant respectfully submits that he has answered each issue raised by the Examiner

and that the application is accordingly in condition for allowance. Allowance is therefore

respectfully requested.

Respectfully submitted,

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